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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

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In re Application of
Michael R. Schramm

Serial No.: 09/867,320

Filed: May 29, 2001

For: Fluid Powered Bubble Machine
With Spill-Proof Capability

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§ Group Art Unit 3751
§
§ Examiner: Steven O.
§ Douglas
§
§

APPEAL BRIEF

Commissioner of Patents
and Trademarks
Washington, D.C. 20231

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DATE OF DEPOSIT: 15 March 2004	
I hereby certify that this correspondence is being deposited with the United States Postal Service as "FIRST CLASS MAIL" in an envelope addressed to: The Commissioner of Patents, PO Box 1450, Alexandria, VA 22313-1450	
Michael R. Schramm Applicant	March 15, 2004 Date
<i>Michael R. Schramm</i> Signature	

Dear Sir:

Pursuant to 37 CFR § 1.192, Appellant submits this Appeal Brief in triplicate to the Board of Patent Appeals and Interferences in support of his appeal from the decision dated November 13, 2003 of the Examiner rejecting claims 36-41 of the captioned application. Appellant submits herewith an appeal fee in the amount of \$165 for a small entity pursuant to 37 CFR § 1.17(c) via a credit card payment using attached form PTO-2038. Appellant submits that the Examiner erred in rejecting the claims, and respectfully requests reversal of the rejection.

(1) Real Party in Interest

The real party in interest is Michael R. Schramm.

(2) Related Appeals and Interferences

Appellant is unaware of any pending appeal or interference which affects this appeal.

(3) Status of Claims

Claims 1-20 are allowed and claims 36-41 are pending and on appeal. Claims 21-35 have been cancelled.

(4) Status of Amendments

The appealed claims have been finally rejected. There has been no amendment filed subsequent to the final rejection of the claims.

(5) Summary of Invention

The present invention is summarized in the specification on page 3, left hand column, lines 31 through 56 and is depicted in the drawings in figures 1 through 5 as facilitated by the reference characters listed in the feature table on page 4 of the specification. The present invention relates to a spill-resistant bubble creation device that both automatically creates bubbles and emits amusing streams of water. The invention has particular application for use by young children in creating streams of water and simultaneously creating bubbles without the mess otherwise associated with conventional spillable bubble devices.

(6) Issues

The issue on appeal is whether or not claims 36-41 are under 35 USC § 251 an improper recapture of broadened claimed subject matter that was surrendered in the application for patent upon which the present reissue is based.

(7) Grouping of Claims

The groups of claims 36-41 should be separately considered. Claim 36 stands or falls alone, claim 37 stands or falls alone, claim 38 stands or falls alone, claim 39 stands or falls alone, claim 40 stands or falls alone, and claim 41 stands or falls alone. The six groups of claims do not stand or fall together.

(8.1) Argument 1, Claim 36- was erroneously rejected as an improper recapture:

Appellant respectfully points out that the six groups of claims 36-41 are separately patentable due to the different subject matter claimed in each claim. Specifically, the claims vary in scope and claimed subject matter due to the different limitations of container shape, bubble creation device type

and geometry, and actuation means. Due to these substantial patentably distinct limitations, each group is seen as being separately patentable and each group of claims is seen as standing or falling separately.

Appellant respectfully traverses the Examiners argument that Appellant's application is an improper recapture of broadened claimed subject matter surrendered in the application for patent upon which the present reissue is based. The examiner noted that, "A broadening aspect is present in the reissue which was not present in the application for patent". The examiner argues that the basis for the rejection is that, "The record of the application for the patent shows that the broadening aspect (in the reissue) relates to subject matter that applicant previously surrendered during the prosecution of the application." The examiner also reiterated patent claim 8 (with emphasis on deleted limitations) and noted that it corresponded to surrendered subject matter. Appellant respectfully notes no further specificity or basis was provided in the office action regarding what established the surrendering of the limitations in question. Accordingly, appellant respectfully suggests that appellant is disadvantaged in his ability to argue against such surrendering. Nevertheless, appellant provides the following argument against the noted surrendering, believing appellant's argument to cover all possible categories of surrender.

Appellant readily agrees that there is a broadening aspect in the pending reissue. Appellant further readily acknowledges that those limitations of patent claim 8 that were "*emphasized*" by the examiner (i.e. a hydraulic motor and an exit port) were omitted from pending claims 36-41. However, appellant respectfully traverses the examiner's position that the now deleted limitations were surrendered during the prosecution of the parent application. Appellant avers that appellant satisfies the requirement of 35 USC § 251 which states, "Whenever any patent is, ...deemed wholly or partly inoperative or invalid, ... by reason of patentee claiming more or less than he had a right to claim in the patent, the Director shall, ... reissue the patent for the invention disclosed in the original patent, and in accordance with a new and amended application ...". In addition to other reasons, the discovery of new created the possibility of required modification of the scope of the claims. However, appellant realizes that although applicant satisfies 35 USC § 251, 251 is silent with respect to recapture. Therefore, in order to establish appellant's conclusion that improper recapture does not exist and that the limitations omitted were not previously surrendered, appellant refers to MPEP § 1412.02 under the

heading “CRITERIA FOR DETERMINING THAT SUBJECT MATTER HAS BEEN SURRENDERED”. The first sentence under the noted heading is repeated here for reference:

If the limitation now being omitted or broadened in the present reissue was originally presented/argued/stated in the original application to make the claims allowable over a rejection or objection made in the original application, the omitted limitation relates to subject matter previously surrendered by applicant, and impermissible recapture exists.

Appellant respectfully points out, that the only limitation that was presented/argued/stated in the original application in claim 8 to make the claim allowable over a rejection or objection was the limitation of “non-cavitation”. Appellant further respectfully points out that as was noted in appellant’s previous office action response, the surrendered limitation is found in each claim of claims 36-41.

Taken a step further, MPEP § 1412.02 provides three distinct examples of how subject matter may be surrendered, namely: Example (A) - Argument without amendment, Example (B) – Amendment without argument, and Example (C) – Examiner’s reasons for allowance without applicant counter. Each example will be addressed below.

With respect to example “A”, the following summarizes the arguments without amendments presented in the prosecution of the parent application:

- 1) In the 12/29/98 OA response: The limitation of “**non-cavitation**” was argued to be not new matter.
- 2) In the 12/29/98 OA response: The limitation of a “**non-bubble liquid emitting device**” was argued to overcome a 35 USC § 102 rejection of the D’Andrade reference. Appellant notes that appellant stated that the “D’Andrade reference does not have a “non-bubble liquid emitting device””, and that (original) claim 8 included the limitation of an “exit port for the emission of hydraulic fluid”. However, as has been pointed out to the appellant in many an office action, statements of intended use do not positively limit the claim. Thus, while an “exit port” is considered a limitation to claim 8, “for the emission of hydraulic fluid”, being a statement of intended use, is therefore not considered a limitation to claim 8.

- 3) In the 12/29/98 OA response: The limitation of “**non-cavitation**” was argued to overcome a 35 USC § 102 rejection of the Henkin reference.

Of the two limitations listed above, the “non-cavitation” limitation, (as noted) is included in all of claims 36-41, and the limitation of “non-bubble liquid emitting device”, although not in any of claims 36-41, was never presented in (original) claim 8. Thus, appellant respectfully suggests by reason of example “A”, that there is no limitation not included in claims 36-41 that was surrendered in claim 8.

With respect to example “B”, there are no limitations by amendment that were made to claim 8 that are not included in claims 36-41. Thus, appellant respectfully suggests by reason of example “B”, that there is no limitation not included in claims 36-41 that was surrendered in claim 8.

With respect to example “C”, example “C” requires that the examiner’s reasons for allowance state, “that it was limitation A which distinguished over a potential combination of references X and Y”. The examiner’s reasons for allowance are general broad based reasons that essentially recite that, “None of the prior art, alone or in combination, teaches Applicant’s invention of ...” and then reiterate a summary of the applicant’s invention. Further, the examiner’s reasons are stated in the alternative (i.e. applicant’s invention of this *or* that). Accordingly, no specific limitation “A” is established as defining over a potential combination of references “X” and “Y”. Thus, appellant respectfully suggests by reason of example “C”, that there is no limitation not included in claims 36-41 that was surrendered in claim 8.

(8.2) Argument 2, Claim 37 was erroneously rejected as an improper recapture:

Appellant respectfully traverses the Examiners argument that Appellant’s application is an improper recapture of broadened claimed subject matter surrendered in the application for patent upon which the present reissue is based. The examiner noted that, “A broadening aspect is present in the reissue which was not present in the application for patent”. The examiner argues that the basis for the rejection is that, “The record of the application for the patent shows that the broadening aspect (in the reissue) relates to subject matter that applicant previously surrendered during the prosecution of the application.” The examiner also reiterated patent claim 8 (with emphasis on deleted limitations) and noted that it corresponded to surrendered subject matter. Appellant respectfully notes no further specificity or basis was provided in the office action regarding what established the surrendering of the

limitations in question. Accordingly, appellant respectfully suggests that appellant is disadvantaged in his ability to argue against such surrendering. Nevertheless, appellant provides the following argument against the noted surrendering, believing appellant's argument to cover all possible categories of surrender.

Appellant readily agrees that there is a broadening aspect in the pending reissue. Appellant further readily acknowledges that those limitations of patent claim 8 that were "*emphasized*" by the examiner (i.e. a hydraulic motor and an exit port) were omitted from pending claims 36-41. However, appellant respectfully traverses the examiner's position that the now deleted limitations were surrendered during the prosecution of the parent application. Appellant avers that appellant satisfies the requirement of 35 USC § 251 which states, "Whenever any patent is, ...deemed wholly or partly inoperative or invalid, ... by reason of patentee claiming more or less than he had a right to claim in the patent, the Director shall, ... reissue the patent for the invention disclosed in the original patent, and in accordance with a new and amended application ...". In addition to other reasons, the discovery of new created the possibility of required modification of the scope of the claims. However, appellant realizes that although applicant satisfies 35 USC § 251, 251 is silent with respect to recapture. Therefore, in order to establish appellant's conclusion that improper recapture does not exist and that the limitations omitted were not previously surrendered, appellant refers to MPEP § 1412.02 under the heading "CRITERIA FOR DETERMINING THAT SUBJECT MATTER HAS BEEN SURRENDERED". The first sentence under the noted heading is repeated here for reference:

If the limitation now being omitted or broadened in the present reissue was originally presented/argued/stated in the original application to make the claims allowable over a rejection or objection made in the original application, the omitted limitation relates to subject matter previously surrendered by applicant, and impermissible recapture exists.

Appellant respectfully points out, that the only limitation that was presented/argued/stated in the original application in claim 8 to make the claim allowable over a rejection or objection was the limitation of "non-cavitation". Appellant further respectfully points out that as was noted in appellant's previous office action response, the surrendered limitation is found in each claim of claims 36-41.

Taken a step further, MPEP § 1412.02 provides three distinct examples of how subject matter may be surrendered, namely: Example (A) - Argument without amendment, Example (B) – Amendment without argument, and Example (C) – Examiner’s reasons for allowance without applicant counter. Each example will be addressed below.

With respect to example “A”, the following summarizes the arguments without amendments presented in the prosecution of the parent application:

- 4) In the 12/29/98 OA response: The limitation of “**non-cavitation**” was argued to be not new matter.
- 5) In the 12/29/98 OA response: The limitation of a “**non-bubble liquid emitting device**” was argued to overcome a 35 USC § 102 rejection of the D’Andrade reference. Appellant notes that appellant stated that the “D’Andrade reference does not have a “non-bubble liquid emitting device””, and that (original) claim 8 included the limitation of an “exit port for the emission of hydraulic fluid”. However, as has been pointed out to the appellant in many an office action, statements of intended use do not positively limit the claim. Thus, while an “exit port” is considered a limitation to claim 8, “for the emission of hydraulic fluid”, being a statement of intended use, is therefore not considered a limitation to claim 8.
- 6) In the 12/29/98 OA response: The limitation of “**non-cavitation**” was argued to overcome a 35 USC § 102 rejection of the Henkin reference.

Of the two limitations listed above, the “non-cavitation” limitation, (as noted) is included in all of claims 36-41, and the limitation of “non-bubble liquid emitting device”, although not in any of claims 36-41, was never presented in (original) claim 8. Thus, appellant respectfully suggests by reason of example “A”, that there is no limitation not included in claims 36-41 that was surrendered in claim 8.

With respect to example “B”, there are no limitations by amendment that were made to claim 8 that are not included in claims 36-41. Thus, appellant respectfully suggests by reason of example “B”, that there is no limitation not included in claims 36-41 that was surrendered in claim 8.

With respect to example “C”, example “C” requires that the examiner’s reasons for allowance state, “that it was limitation A which distinguished over a potential combination of references X and Y”. The examiner’s reasons for allowance are general broad based reasons that essentially recite that, “None of the prior art, alone or in combination, teaches Applicant’s invention of ...” and then reiterate

a summary of the applicant's invention. Further, the examiner's reasons are stated in the alternative (i.e. applicant's invention of this *or* that). Accordingly, no specific limitation "A" is established as defining over a potential combination of references "X" and "Y". Thus, appellant respectfully suggests by reason of example "C", that there is no limitation not included in claims 36-41 that was surrendered in claim 8.

(8.3) Argument 3, Claim 38 was erroneously rejected as an improper recapture:

Appellant respectfully traverses the Examiners argument that Appellant's application is an improper recapture of broadened claimed subject matter surrendered in the application for patent upon which the present reissue is based. The examiner noted that, "A broadening aspect is present in the reissue which was not present in the application for patent". The examiner argues that the basis for the rejection is that, "The record of the application for the patent shows that the broadening aspect (in the reissue) relates to subject matter that applicant previously surrendered during the prosecution of the application." The examiner also reiterated patent claim 8 (with emphasis on deleted limitations) and noted that it corresponded to surrendered subject matter. Appellant respectfully notes no further specificity or basis was provided in the office action regarding what established the surrendering of the limitations in question. Accordingly, appellant respectfully suggests that appellant is disadvantaged in his ability to argue against such surrendering. Nevertheless, appellant provides the following argument against the noted surrendering, believing appellant's argument to cover all possible categories of surrender.

Appellant readily agrees that there is a broadening aspect in the pending reissue. Appellant further readily acknowledges that those limitations of patent claim 8 that were "*emphasized*" by the examiner (i.e. a hydraulic motor and an exit port) were omitted from pending claims 36-41. However, appellant respectfully traverses the examiner's position that the now deleted limitations were surrendered during the prosecution of the parent application. Appellant avers that appellant satisfies the requirement of 35 USC § 251 which states, "Whenever any patent is, ...deemed wholly or partly inoperative or invalid, ... by reason of patentee claiming more or less than he had a right to claim in the patent, the Director shall, ... reissue the patent for the invention disclosed in the original patent, and in accordance with a new and amended application ...". In addition to other reasons, the discovery of

new created the possibility of required modification of the scope of the claims. However, appellant realizes that although applicant satisfies 35 USC § 251, 251 is silent with respect to recapture. Therefore, in order to establish appellant's conclusion that improper recapture does not exist and that the limitations omitted were not previously surrendered, appellant refers to MPEP § 1412.02 under the heading "CRITERIA FOR DETERMINING THAT SUBJECT MATTER HAS BEEN SURRENDERED". The first sentence under the noted heading is repeated here for reference:

If the limitation now being omitted or broadened in the present reissue was originally presented/argued/stated in the original application to make the claims allowable over a rejection or objection made in the original application, the omitted limitation relates to subject matter previously surrendered by applicant, and impermissible recapture exists.

Appellant respectfully points out, that the only limitation that was presented/argued/stated in the original application in claim 8 to make the claim allowable over a rejection or objection was the limitation of "non-cavitation". Appellant further respectfully points out that as was noted in appellant's previous office action response, the surrendered limitation is found in each claim of claims 36-41.

Taken a step further, MPEP § 1412.02 provides three distinct examples of how subject matter may be surrendered, namely: Example (A) - Argument without amendment, Example (B) - Amendment without argument, and Example (C) – Examiner's reasons for allowance without applicant counter. Each example will be addressed below.

With respect to example "A", the following summarizes the arguments without amendments presented in the prosecution of the parent application:

- 7) In the 12/29/98 OA response: The limitation of "non-cavitation" was argued to be not new matter.
- 8) In the 12/29/98 OA response: The limitation of a "non-bubble liquid emitting device" was argued to overcome a 35 USC § 102 rejection of the D'Andrade reference. Appellant notes that appellant stated that the "D'Andrade reference does not have a "non-bubble liquid emitting device""", and that (original) claim 8 included the limitation of an "exit port for the emission of hydraulic fluid". However, as has been pointed out to the appellant in many an office action,

statements of intended use do not positively limit the claim. Thus, while an “exit port” is considered a limitation to claim 8, “for the emission of hydraulic fluid”, being a statement of intended use, is therefore not considered a limitation to claim 8.

- 9) In the 12/29/98 OA response: The limitation of “**non-cavitation**” was argued to overcome a 35 USC § 102 rejection of the Henkin reference.

Of the two limitations listed above, the “non-cavitation” limitation, (as noted) is included in all of claims 36-41, and the limitation of “non-bubble liquid emitting device”, although not in any of claims 36-41, was never presented in (original) claim 8. Thus, appellant respectfully suggests by reason of example “A”, that there is no limitation not included in claims 36-41 that was surrendered in claim 8.

With respect to example “B”, there are no limitations by amendment that were made to claim 8 that are not included in claims 36-41. Thus, appellant respectfully suggests by reason of example “B”, that there is no limitation not included in claims 36-41 that was surrendered in claim 8.

With respect to example “C”, example “C” requires that the examiner’s reasons for allowance state, “that it was limitation A which distinguished over a potential combination of references X and Y”. The examiner’s reasons for allowance are general broad based reasons that essentially recite that, “None of the prior art, alone or in combination, teaches Applicant’s invention of ...” and then reiterate a summary of the applicant’s invention. Further, the examiner’s reasons are stated in the alternative (i.e. applicant’s invention of this *or* that). Accordingly, no specific limitation “A” is established as defining over a potential combination of references “X” and “Y”. Thus, appellant respectfully suggests by reason of example “C”, that there is no limitation not included in claims 36-41 that was surrendered in claim 8.

(8.4) Argument 4, Claim 39 was erroneously rejected as an improper recapture:

Appellant respectfully traverses the Examiners argument that Appellant’s application is an improper recapture of broadened claimed subject matter surrendered in the application for patent upon which the present reissue is based. The examiner noted that, “A broadening aspect is present in the reissue which was not present in the application for patent”. The examiner argues that the basis for the rejection is that, “The record of the application for the patent shows that the broadening aspect (in the reissue) relates to subject matter that applicant previously surrendered during the prosecution of the

application.” The examiner also reiterated patent claim 8 (with emphasis on deleted limitations) and noted that it corresponded to surrendered subject matter. Appellant respectfully notes no further specificity or basis was provided in the office action regarding what established the surrendering of the limitations in question. Accordingly, appellant respectfully suggests that appellant is disadvantaged in his ability to argue against such surrendering. Nevertheless, appellant provides the following argument against the noted surrendering, believing appellant’s argument to cover all possible categories of surrender.

Appellant readily agrees that there is a broadening aspect in the pending reissue. Appellant further readily acknowledges that those limitations of patent claim 8 that were “*emphasized*” by the examiner (i.e. a hydraulic motor and an exit port) were omitted from pending claims 36-41. However, appellant respectfully traverses the examiner’s position that the now deleted limitations were surrendered during the prosecution of the parent application. Appellant avers that appellant satisfies the requirement of 35 USC § 251 which states, “Whenever any patent is, ...deemed wholly or partly inoperative or invalid, ... by reason of patentee claiming more or less than he had a right to claim in the patent, the Director shall, ... reissue the patent for the invention disclosed in the original patent, and in accordance with a new and amended application ...”. In addition to other reasons, the discovery of new created the possibility of required modification of the scope of the claims. However, appellant realizes that although applicant satisfies 35 USC § 251, 251 is silent with respect to recapture. Therefore, in order to establish appellant’s conclusion that improper recapture does not exist and that the limitations omitted were not previously surrendered, appellant refers to MPEP § 1412.02 under the heading “CRITERIA FOR DETERMINING THAT SUBJECT MATTER HAS BEEN SURRENDERED”. The first sentence under the noted heading is repeated here for reference:

If the limitation now being omitted or broadened in the present reissue was originally presented/argued/stated in the original application to make the claims allowable over a rejection or objection made in the original application, the omitted limitation relates to subject matter previously surrendered by applicant, and impermissible recapture exists.

Appellant respectfully points out, that the only limitation that was presented/argued/stated in the original application in claim 8 to make the claim allowable over a rejection or objection was the

limitation of “non-cavitation”. Appellant further respectfully points out that as was noted in appellant’s previous office action response, the surrendered limitation is found in each claim of claims 36-41.

Taken a step further, MPEP § 1412.02 provides three distinct examples of how subject matter may be surrendered, namely: Example (A) - Argument without amendment, Example (B) – Amendment without argument, and Example (C) – Examiner’s reasons for allowance without applicant counter. Each example will be addressed below.

With respect to example “A”, the following summarizes the arguments without amendments presented in the prosecution of the parent application:

10) In the 12/29/98 OA response: The limitation of “**non-cavitation**” was argued to be not new matter.

11) In the 12/29/98 OA response: The limitation of a “**non-bubble liquid emitting device**” was argued to overcome a 35 USC § 102 rejection of the D’Andrade reference. Appellant notes that appellant stated that the “D’Andrade reference does not have a “non-bubble liquid emitting device””, and that (original) claim 8 included the limitation of an “exit port for the emission of hydraulic fluid”. However, as has been pointed out to the appellant in many an office action, statements of intended use do not positively limit the claim. Thus, while an “exit port” is considered a limitation to claim 8, “for the emission of hydraulic fluid”, being a statement of intended use, is therefore not considered a limitation to claim 8.

12) In the 12/29/98 OA response: The limitation of “**non-cavitation**” was argued to overcome a 35 USC § 102 rejection of the Henkin reference.

Of the two limitations listed above, the “non-cavitation” limitation, (as noted) is included in all of claims 36-41, and the limitation of “non-bubble liquid emitting device”, although not in any of claims 36-41, was never presented in (original) claim 8. Thus, appellant respectfully suggests by reason of example “A”, that there is no limitation not included in claims 36-41 that was surrendered in claim 8.

With respect to example “B”, there are no limitations by amendment that were made to claim 8 that are not included in claims 36-41. Thus, appellant respectfully suggests by reason of example “B”, that there is no limitation not included in claims 36-41 that was surrendered in claim 8.

With respect to example “C”, example “C” requires that the examiner’s reasons for allowance state, “that it was limitation A which distinguished over a potential combination of references X and Y”. The examiner’s reasons for allowance are general broad based reasons that essentially recite that, “None of the prior art, alone or in combination, teaches Applicant’s invention of …” and then reiterate a summary of the applicant’s invention. Further, the examiner’s reasons are stated in the alternative (i.e. applicant’s invention of this *or* that). Accordingly, no specific limitation “A” is established as defining over a potential combination of references “X” and “Y”. Thus, appellant respectfully suggests by reason of example “C”, that there is no limitation not included in claims 36-41 that was surrendered in claim 8.

(8.5) Argument 5, Claim 40 was erroneously rejected as an improper recapture:

Appellant respectfully traverses the Examiners argument that Appellant’s application is an improper recapture of broadened claimed subject matter surrendered in the application for patent upon which the present reissue is based. The examiner noted that, “A broadening aspect is present in the reissue which was not present in the application for patent”. The examiner argues that the basis for the rejection is that, “The record of the application for the patent shows that the broadening aspect (in the reissue) relates to subject matter that applicant previously surrendered during the prosecution of the application.” The examiner also reiterated patent claim 8 (with emphasis on deleted limitations) and noted that it corresponded to surrendered subject matter. Appellant respectfully notes no further specificity or basis was provided in the office action regarding what established the surrendering of the limitations in question. Accordingly, appellant respectfully suggests that appellant is disadvantaged in his ability to argue against such surrendering. Nevertheless, appellant provides the following argument against the noted surrendering, believing appellant’s argument to cover all possible categories of surrender.

Appellant readily agrees that there is a broadening aspect in the pending reissue. Appellant further readily acknowledges that those limitations of patent claim 8 that were “*emphasized*” by the examiner (i.e. a hydraulic motor and an exit port) were omitted from pending claims 36-41. However, appellant respectfully traverses the examiner’s position that the now deleted limitations were surrendered during the prosecution of the parent application. Appellant avers that appellant satisfies

the requirement of 35 USC § 251 which states, “Whenever any patent is, ...deemed wholly or partly inoperative or invalid, ... by reason of patentee claiming more or less than he had a right to claim in the patent, the Director shall, ... reissue the patent for the invention disclosed in the original patent, and in accordance with a new and amended application ...”. In addition to other reasons, the discovery of new created the possibility of required modification of the scope of the claims. However, appellant realizes that although applicant satisfies 35 USC § 251, 251 is silent with respect to recapture. Therefore, in order to establish appellant’s conclusion that improper recapture does not exist and that the limitations omitted were not previously surrendered, appellant refers to MPEP § 1412.02 under the heading “CRITERIA FOR DETERMINING THAT SUBJECT MATTER HAS BEEN SURRENDERED”. The first sentence under the noted heading is repeated here for reference:

If the limitation now being omitted or broadened in the present reissue was originally presented/argued/stated in the original application to make the claims allowable over a rejection or objection made in the original application, the omitted limitation relates to subject matter previously surrendered by applicant, and impermissible recapture exists.

Appellant respectfully points out, that the only limitation that was presented/argued/stated in the original application in claim 8 to make the claim allowable over a rejection or objection was the limitation of “non-cavitation”. Appellant further respectfully points out that as was noted in appellant’s previous office action response, the surrendered limitation is found in each claim of claims 36-41.

Taken a step further, MPEP § 1412.02 provides three distinct examples of how subject matter may be surrendered, namely: Example (A) - Argument without amendment, Example (B) – Amendment without argument, and Example (C) – Examiner’s reasons for allowance without applicant counter. Each example will be addressed below.

With respect to example “A”, the following summarizes the arguments without amendments presented in the prosecution of the parent application:

13) In the 12/29/98 OA response: The limitation of “non-cavitation” was argued to be not new matter.

14) In the 12/29/98 OA response: The limitation of a “**non-bubble liquid emitting device**” was argued to overcome a 35 USC § 102 rejection of the D’Andrade reference. Appellant notes that appellant stated that the “D’Andrade reference does not have a “non-bubble liquid emitting device””, and that (original) claim 8 included the limitation of an “exit port for the emission of hydraulic fluid”. However, as has been pointed out to the appellant in many an office action, statements of intended use do not positively limit the claim. Thus, while an “exit port” is considered a limitation to claim 8, “for the emission of hydraulic fluid”, being a statement of intended use, is therefore not considered a limitation to claim 8.

15) In the 12/29/98 OA response: The limitation of “**non-cavitation**” was argued to overcome a 35 USC § 102 rejection of the Henkin reference.

Of the two limitations listed above, the “non-cavitation” limitation, (as noted) is included in all of claims 36-41, and the limitation of “non-bubble liquid emitting device”, although not in any of claims 36-41, was never presented in (original) claim 8. Thus, appellant respectfully suggests by reason of example “A”, that there is no limitation not included in claims 36-41 that was surrendered in claim 8.

With respect to example “B”, there are no limitations by amendment that were made to claim 8 that are not included in claims 36-41. Thus, appellant respectfully suggests by reason of example “B”, that there is no limitation not included in claims 36-41 that was surrendered in claim 8.

With respect to example “C”, example “C” requires that the examiner’s reasons for allowance state, “that it was limitation A which distinguished over a potential combination of references X and Y”. The examiner’s reasons for allowance are general broad based reasons that essentially recite that, “None of the prior art, alone or in combination, teaches Applicant’s invention of ...” and then reiterate a summary of the applicant’s invention. Further, the examiner’s reasons are stated in the alternative (i.e. applicant’s invention of this *or* that). Accordingly, no specific limitation “A” is established as defining over a potential combination of references “X” and “Y”. Thus, appellant respectfully suggests by reason of example “C”, that there is no limitation not included in claims 36-41 that was surrendered in claim 8.

(8.6) Argument 6, Claim 41 was erroneously rejected as an improper recapture:

Appellant respectfully traverses the Examiners argument that Appellant's application is an improper recapture of broadened claimed subject matter surrendered in the application for patent upon which the present reissue is based. The examiner noted that, "A broadening aspect is present in the reissue which was not present in the application for patent". The examiner argues that the basis for the rejection is that, "The record of the application for the patent shows that the broadening aspect (in the reissue) relates to subject matter that applicant previously surrendered during the prosecution of the application." The examiner also reiterated patent claim 8 (with emphasis on deleted limitations) and noted that it corresponded to surrendered subject matter. Appellant respectfully notes no further specificity or basis was provided in the office action regarding what established the surrendering of the limitations in question. Accordingly, appellant respectfully suggests that appellant is disadvantaged in his ability to argue against such surrendering. Nevertheless, appellant provides the following argument against the noted surrendering, believing appellant's argument to cover all possible categories of surrender.

Appellant readily agrees that there is a broadening aspect in the pending reissue. Appellant further readily acknowledges that those limitations of patent claim 8 that were "*emphasized*" by the examiner (i.e. a hydraulic motor and an exit port) were omitted from pending claims 36-41. However, appellant respectfully traverses the examiner's position that the now deleted limitations were surrendered during the prosecution of the parent application. Appellant avers that appellant satisfies the requirement of 35 USC § 251 which states, "Whenever any patent is, ...deemed wholly or partly inoperative or invalid, ... by reason of patentee claiming more or less than he had a right to claim in the patent, the Director shall, ... reissue the patent for the invention disclosed in the original patent, and in accordance with a new and amended application ...". In addition to other reasons, the discovery of new created the possibility of required modification of the scope of the claims. However, appellant realizes that although applicant satisfies 35 USC § 251, 251 is silent with respect to recapture. Therefore, in order to establish appellant's conclusion that improper recapture does not exist and that the limitations omitted were not previously surrendered, appellant refers to MPEP § 1412.02 under the heading "CRITERIA FOR DETERMINING THAT SUBJECT MATTER HAS BEEN SURRENDERED". The first sentence under the noted heading is repeated here for reference:

If the limitation now being omitted or broadened in the present reissue was originally presented/argued/stated in the original application to make the claims allowable over a rejection or objection made in the original application, the omitted limitation relates to subject matter previously surrendered by applicant, and impermissible recapture exists.

Appellant respectfully points out, that the only limitation that was presented/argued/stated in the original application in claim 8 to make the claim allowable over a rejection or objection was the limitation of “non-cavitation”. Appellant further respectfully points out that as was noted in appellant’s previous office action response, the surrendered limitation is found in each claim of claims 36-41.

Taken a step further, MPEP § 1412.02 provides three distinct examples of how subject matter may be surrendered, namely: Example (A) - Argument without amendment, Example (B) – Amendment without argument, and Example (C) – Examiner’s reasons for allowance without applicant counter. Each example will be addressed below.

With respect to example “A”, the following summarizes the arguments without amendments presented in the prosecution of the parent application:

- 16) In the 12/29/98 OA response: The limitation of “**non-cavitation**” was argued to be not new matter.
- 17) In the 12/29/98 OA response: The limitation of a “**non-bubble liquid emitting device**” was argued to overcome a 35 USC § 102 rejection of the D’Andrade reference. Appellant notes that appellant stated that the “D’Andrade reference does not have a “non-bubble liquid emitting device””, and that (original) claim 8 included the limitation of an “exit port for the emission of hydraulic fluid”. However, as has been pointed out to the appellant in many an office action, statements of intended use do not positively limit the claim. Thus, while an “exit port” is considered a limitation to claim 8, “for the emission of hydraulic fluid”, being a statement of intended use, is therefore not considered a limitation to claim 8.
- 18) In the 12/29/98 OA response: The limitation of “**non-cavitation**” was argued to overcome a 35 USC § 102 rejection of the Henkin reference.

Of the two limitations listed above, the “non-cavitation” limitation, (as noted) is included in all of claims 36-41, and the limitation of “non-bubble liquid emitting device”, although not in any of claims

36-41, was never presented in (original) claim 8. Thus, appellant respectfully suggests by reason of example “A”, that there is no limitation not included in claims 36-41 that was surrendered in claim 8.

With respect to example “B”, there are no limitations by amendment that were made to claim 8 that are not included in claims 36-41. Thus, appellant respectfully suggests by reason of example “B”, that there is no limitation not included in claims 36-41 that was surrendered in claim 8.

With respect to example “C”, example “C” requires that the examiner’s reasons for allowance state, “that it was limitation A which distinguished over a potential combination of references X and Y”. The examiner’s reasons for allowance are general broad based reasons that essentially recite that, “None of the prior art, alone or in combination, teaches Applicant’s invention of ...” and then reiterate a summary of the applicant’s invention. Further, the examiner’s reasons are stated in the alternative (i.e. applicant’s invention of this *or* that). Accordingly, no specific limitation “A” is established as defining over a potential combination of references “X” and “Y”. Thus, appellant respectfully suggests by reason of example “C”, that there is no limitation not included in claims 36-41 that was surrendered in claim 8.

(9) **Appendix**

The following are the claims involved with this appeal.

36. A non-cavitation bubble creation apparatus comprising a bubble creation device and a container wherein said container defines at least one container of the following group of containers comprising a container defining an inner cavity of a predetermined length and having an open funnel extending into said cavity and wherein said funnel is at least half as long as said length of said cavity, a container defining an inner cavity and having a open funnel extending into said cavity said funnel having an inner opening and wherein said inner opening is substantially centrally located within said cavity, a container defining an inner cavity and having a substantially rectangular shaped open funnel and wherein said container resists spillage of a predetermined amount of liquid contents of said container when said container is oriented in any position, and a container defining an inner cavity having an open non-cylindrical/non-conical funnel and wherein said container resists spillage of a predetermined amount of liquid contents of said container when said container is oriented in any position.
37. A non-cavitation bubble creation apparatus comprising a bubble creation device and a container having an inner cavity and an open funnel extending into said cavity wherein said container resists spillage of a predetermined amount of liquid contents of said container when said container is oriented in any position and wherein said bubble creation device defines at least one bubble creation device of the following group of bubble creation devices comprising a bubble creation device having a plurality of bubble orifices, a bubble creation device defining a bubble wheel having at least one bubble orifice, and a bubble creation device having a first portion and a second portion and wherein said first portion includes at least one bubble orifice and wherein said second portion defines a portion that remains within said funnel when a bubble is created.
38. A non-cavitation bubble creation apparatus comprising a bubble creation device and a container defining an inner cavity having a first opening wherein said first opening includes a open funnel connected to said first opening and extending into said cavity and wherein said container includes a second opening having an opening cover removeably

connected to said second opening and wherein said bubble creation device is mechanically actuateable into and out of said container.

39. A non-cavitation bubble creation apparatus comprising a bubble creation device and a container having an inner cavity and an open funnel extending into said cavity wherein said container resists spillage of a predetermined amount of liquid contents of said container when said container is oriented in any position and wherein said bubble creation device defines a bubble creation device having at least one substantially planer bubble orifice defining a plane and wherein said bubble creation device is moveable into and out of said container by moving along a path through said funnel, and wherein said path through said funnel defines an axis, and wherein said axis lies substantially within said orifice plane when said bubble orifice moves through said funnel.
40. A non-cavitation bubble creation apparatus comprising a bubble creation device and a container having an inner cavity and an open funnel extending into said cavity wherein said container resists spillage of a predetermined amount of liquid contents of said container when said container is oriented in any position and wherein said bubble creation device is movably connected to said container and wherein said bubble creation device is mechanically actuateable into and out of said container.
41. A non-cavitation bubble creation apparatus comprising a bubble creation device having at least one bubble orifice of a predetermined length and a container having an inner cavity and an open funnel of a predetermined length extending lengthwise into said cavity and wherein said length of said funnel exceeds said length of said orifice.

(10) **Conclusion**

In view of the comments above, it is submitted the Examiner erred in rejecting the claims on appeal. Appellant therefore respectfully requests that this Honorable Board reverse the Examiner's rejection of the claims. If the Board has any questions or comments which may be resolved over the telephone, the board is requested to call Michael R. Schramm at 801-625-9268 (wk) or at 435-734-2599 (hm).

DATE: March 15, 2004 Respectfully submitted,



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